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*Admitted only in Maryland
*Admitted only in Virginia
*Practice Limited to
Federal Agencies

August 11, 2004

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BRIAND@SKGF.COM

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Mail Stop Amendment

Re: U.S. Utility Patent Application
Appl. No. 09/855,797; Filed: May 16, 2001
For: **Recombinational Cloning Using Nucleic Acids Having
Recombination Sites**
Inventors: HARTLEY *et al.*
Our Ref: 0942.285000G/RWE/BJD/JKM

Sir:

Transmitted herewith for appropriate action are the following documents:

1. PTO Fee Transmittal Form (PTO/SB/17);
2. PTO-2038 Credit Card Payment Form in the amount of \$180.00 to cover IDS late filing surcharge;
3. Third Supplemental Information Disclosure Statement;
4. List of cited references on Form PTO-1449 (6 sheets);
5. A copy of the following references cited on Form PTO-1449 (15 documents: AN9 and AT112-AR117); and
6. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
August 11, 2004
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

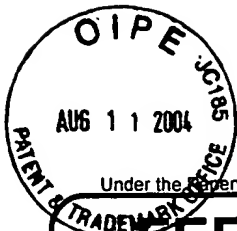
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Brian J. Del Buono", written over a horizontal line.

Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

BJD/JKM:bac

297027_1.DOC



AUG 11 2004

PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 180.00

Complete if Known

Application Number	09/855,797
Filing Date	May 16, 2001
First Named Inventor	James L. HARTLEY
Examiner Name	Leffers Jr., G.G.
Art Unit	1636
Attorney Docket No.	0942.285000G/RWE/BJD

METHOD OF PAYMENT (check all that apply)☐ Check ☒ Credit card ☐ Money Order ☒ Other** ☐ None☐ *Charge any deficiencies or credit any overpayments in the fees to Deposit Acct. No. 19-0036.Deposit Account Number: 19-0036
Deposit Account Name: Sterne, Kessler, Goldstein & Fox P.L.L.C.

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments☐ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity	Small Entity	Fee Description	Fee Paid
Fee Code (\$)	Fee Code (\$)		
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1)			0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	- 20 **=	X	
Multiple Dependent	- 3 **=	X	

Large Entity	Small Entity	Fee Description
Fee Code (\$)	Fee Code (\$)	
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	180.00
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 180.00

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)	Brian J. Del Buono	Registration No. (Attorney/Agent)	42,473	Telephone	(202) 371-2600
Signature		Date	August 11, 2004		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hartley *et al.*

Appl. No. 09/855,797

Filed: May 16, 2001

For: **Recombinational Cloning
Using Nucleic Acids Having
Recombination Sites**

Confirmation No. 2106

Art Unit: 1636

Examiner: Leffers Jr., G.G.

Atty. Docket: 0942.285000G/RWE/BJD/JKM

Third Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450
Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. A copy of each document is provided.

The numbering on this Third Supplemental Information Disclosure Statement is a continuation of the numbering in Applicants' Second Supplemental Information Disclosure Statement filed November 4, 2003, in connection with the above-captioned application.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not

Hartley *et al.*
Appl. No. 09/855,797

be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Third Supplemental Information Disclosure Statement is being filed more than three months after the U.S. filing date and after the mailing date of the first Office Action on the merits, but before the mailing date of a Final Rejection, or Notice of Allowance, or an action that otherwise closes prosecution in the application.

Attached is our PTO-2038 Credit Card Payment Form in the amount of \$180.00 for payment of the fee under 37 C.F.R. § 1.17(p).

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Brian J. Del Buono
Attorney for Applicants
Registration No. 42,473

Date: Aug. 11, 2004
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

FORM PTO-1449

AUG 11 2004

THIRD SUPPLEMENTARY
INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.
0942.285000G/RWE/BJD/JKMAPPLICATION NO.
09/855,797FIRST NAMED INVENTOR
Hartley *et al.*FILING DATE
May 16, 2001ART UNIT
1636

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA						
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FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN9	WO 02/00875	01/03/2002	WIPO			Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

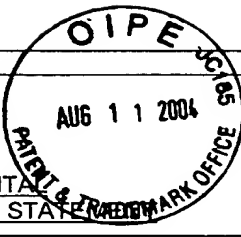
	AR		
	AS		
	AT	112	Kuempel, P., <i>et al.</i> , "Use of a transposon (Tndif) to obtain suppressing and nonsuppressing insertions of the <i>dif</i> resolvase site of <i>Escherichia coli</i> ," <i>Genes Dev.</i> 10:1162-1171, Cold Spring Harbor Laboratory Press (July 1, 1996)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

Page 2 of 6



FORM PTO-1449

THIRD SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO. 0942.285000G/RWE/BJD/JKM	APPLICATION NO. 09/855,797
FIRST NAMED INVENTOR Hartley <i>et al.</i>	
FILING DATE May 16, 2001	ART UNIT 1636

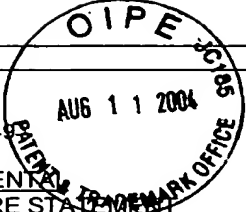
U.S. PATENT DOCUMENTS							
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EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
AR	<u>113</u>	Lee, M.H., <i>et al.</i> , "Site-specific integration of mycobacteriophage L5: Integration-proficient vectors for <i>Mycobacterium smegmatis</i> , <i>Mycobacterium tuberculosis</i> and bacille Calmette-Guérin," <i>Proc. Natl. Acad. Sci. USA</i> 88:3111-3115, National Academy of Sciences (1991).	
AS	<u>113</u>	Manning, P.A., <i>et al.</i> , "Gene Capture in <i>Vibrio cholera</i> ," <i>Trends in Microbiology</i> 7:93-95, Elsevier Science (1999).	
AT	<u>113</u>	Shuman, S., "Novel Approach to Molecular Cloning and Polynucleotide Synthesis Using Vaccina DNA Topoisomerase," <i>J. Biol. Chem.</i> 269:32678-32684, The American Society for Biochemistry and Molecular Biology, Inc. (1994).	

EXAMINER	DATE CONSIDERED
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

		Page 3 of 6	
FORM PTO-1449 THIRD SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT		ATTY. DOCKET NO. 0942.285000G/RWE/BJD/JKM	APPLICATION NO. 09/855,797
FIRST NAMED INVENTOR Hartley <i>et al.</i>		FILING DATE May 16, 2001	
ART UNIT 1636		ART UNIT 1636	

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
AR	<u>114</u>	Zechiedrich, E.L., <i>et al.</i> , "Topoisomerase IV, not gyrase, decatenates products of site-specific recombination in <i>Escherichia coli</i> ," <i>Genes Dev.</i> 11:2580-2592, Cold Spring Harbor Laboratory Press (1997).	
AS	<u>114</u>	Institut Pasteur Website, Introduction: http://www.pasteur.fr/recherche/unites/pmtg/integ/intro.html (accessed 6/19/2003).	
AT	<u>114</u>	Institut Pasteur Website, Figure 1: http://www.pasteur.fr/recherche/unites/pmtg/integ/fig1.html (accessed 6/19/2003).	

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AUG 11 2004

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	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>115</u>	Institut Pasteur Website, Figure 2: http://www.pasteur.fr/recherche/unites/pmtg/integ/fig2.html (accessed 6/19/2003).
	AS	<u>115</u>	Institut Pasteur Website, Figure 3: http://www.pasteur.fr/recherche/unites/pmtg/integ/fig3.html (accessed 6/19/2003).
	AT	<u>115</u>	Institut Pasteur Website, Main page: http://www.pasteur.fr/recherche/unites/pmtg (accessed 6/19/2003).

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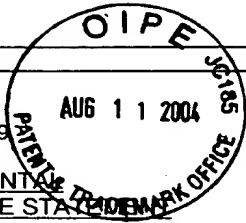
AR	<u>116</u>	Ball, C.A. and Johnson, R.C. "Efficient Excision of Phage λ from the <i>Escherichia coli</i> Chromosome Requires the Fis Protein," <i>J. Bacteriol.</i> 173: 4027-4031, American Society for Microbiology (July 1991).
AS	<u>116</u>	Lenski, <i>et al.</i> , "Genetic Analysis of a Plasmid-Encoded, Host Genotype-Specific Enhancement of Bacterial Fitness," <i>Journal of Bacteriology</i> 176:3140-3147, American Society for Microbiology (1994).
AT	<u>116</u>	Ohara, O. and Temple, G., "Directional cDNA library construction assisted by the <i>in vitro</i> recombination reaction," <i>Nucleic Acids Research</i> 29:e22(1-8), Oxford University Press (2001).

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Page 6 of 6



FORM PTO-1449

THIRD SUPPLEMENTARY
INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO. 0942.285000G/RWE/BJD/JKM	APPLICATION NO. 09/855,797
FIRST NAMED INVENTOR Hartley <i>et al.</i>	
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	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>117</u>	Stuurman, J. <i>et al.</i> , "Single-site manipulation of tomato chromosomes <i>in vitro</i> and <i>in vivo</i> using Cre-lox site-specific recombination," <i>Plant Molecular Biology</i> 32:901-913, Kluwer Academic Publishers (November 27, 1996).
	AS		
	AT		

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